In Response to the Office Communication of April 19, 2007

Atty Docket No: 000309.0049

REMARKS

I. Introduction

Favorable reconsideration of this application, in light of following discussion, is respectfully requested.

II. STATUS OF THE CLAIMS

Claims 39-46 are pending. Claims 1-38 were previously cancelled without prejudice or disclaimer. No claims are newly added, amended, or cancelled herewith.

III. SUMMARY OF THE OFFICE ACTION

In the Office Action, Claims 39, 40, and 43 were rejected as clearly anticipated by *McGraw et al.* (U.S. Patent No. 6,393,328, hereafter *McGraw*). Claims 39-42 and 45-46 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Keegan, Jr.* (U.S. Patent No. 3,083,712, hereafter *Keegan*). Claims 39-42 were also rejected under 35 U.S.C. § 102 as anticipated *Aleev et al.* (U.S. Patent No. 4,165,750, hereafter *Aleev*). Additionally, Claims 39-42 were rejected as anticipated by *Cywinski* (U.S. Patent No. 5,350,415). Claim 43 was rejected under 35 U.S.C. § 103 as unpatentable over *Keegan*. Finally, Claims 39, 43, and 44 were rejected under 35 U.S.C. § 103 as unpatentable over *Reiss* (U.S. Patent No. 5,324,317) in view of *Keegan*.

IV. ARGUMENTS

A. Claims 39, 40, and 43 Patentably Distinguish Over *McGraw*, and the Office Action Has Not Provided Any Analysis to the Contrary

Independent Claim 39, from which Claims 40 and 43 depend, recites, in part, that "the electrical stimulation is adapted to mimic a sequencing of at least two muscle groups proximate to the body segment and is sufficient to achieve visible and forceful contraction of the at least two muscle groups."

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As described in the specification, for example, at pages 4-5, electrodes 404 promote

electrical stimulation of the surrounding musculature of the joint 402 of the respective body

segment 400. The electrodes 404 may be placed at predetermined locations to mimic the natural

movement pattern of the affected joint 402. According to the claimed invention, it is possible to

mimic a natural functioning of the affected joint without the wear and tear commonly associated

with physical activity.

McGraw does not disclose or suggest that "the electrical stimulation is adapted to mimic

a sequencing of at least two muscle groups proximate to the body segment and is sufficient to

achieve forceful contraction of the at least two muscle groups." As the Office Action has not

provided any reasoning or cited to any support in McGraw to show that this feature is disclosed

therein, it is respectfully submitted that the outstanding Office Action has failed to provide a

prima facie case of anticipation. It is therefore respectfully requested that this rejection be

withdrawn.

В. Claims 39-43 and 45-46 Are Not Anticipated or Rendered Obvious by

Keegan

As noted above, independent Claim 39, from which Claims 40-43, 45, and 46 depend,

recites, in part, that "the electrical stimulation is adapted to mimic a sequencing of at least two

muscle groups proximate to the body segment and is sufficient to achieve visible and forceful

contraction of the at least two muscle groups."

At pages 2-3, the Office Action states, with reference to Keegan, that "Examiner

considers such sequential programming 'to mimic a sequencing of at least two muscle groups

proximate to the body segment' since such stimulation sequence includes a proper time relation

Because the Office Action has provided no legal or factual basis to support this rejection, it is respectfully submitted that the next Office Action cannot properly be made final.

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required for normal function of the muscles." However, there is nothing in Keegan that supports

this conclusion. Accordingly, it is respectfully requested that this rejection be withdrawn.

C. Claims 39-42 Patentably Distinguish Over Aleev

As previously explained, independent Claim 39, from which Claims 40-42 depend,

recites, in part, that "the electrical stimulation is adapted to mimic a sequencing of at least two

muscle groups proximate to the body segment and is sufficient to achieve visible and forceful

contraction of the at least two muscle groups."

Like the other applied references, Aleev does not disclose or suggest this claimed feature.

In fact, the outstanding Office Action admits at page 3 that Aleev does not disclose or suggest

"sequencing at least two muscle groups proximate to the body segment" Rather, the Office

Action relies upon an unsubstantiated conclusion that Aleev satisfies this claimed feature. An

unsubstantiated conclusion does not provide a prima facie case of anticipation. Therefore, it is

respectfully requested that this rejection be withdrawn.

D. Claims 39-42 Also Patentably Distinguish Over Cywinski

As previously explained, independent Claim 39, from which Claims 40-42 depend,

recites, in part, that "the electrical stimulation is adapted to mimic a sequencing of at least two

muscle groups proximate to the body segment and is sufficient to achieve visible and forceful

contraction of the at least two muscle groups."

Cywinski suffers from the same defects noted above with the other applied references – it

does not disclose or suggest this claimed feature. Accordingly, it is respectfully requested that

this rejection be withdrawn.

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E. Claims 39, 43, and 44 Are Not Obvious Over the Combination of *Reiss* and *Keegan*

As previously explained, independent Claim 39, from which Claims 43 and 44 depend, recites, in part, that "the electrical stimulation is adapted to mimic a sequencing of at least two muscle groups proximate to the body segment and is sufficient to achieve visible and forceful contraction of the at least two muscle groups."

The outstanding Office Action admits, at page 6, that *Reiss* does not disclose or suggest this feature. The Office Action attempts to remedy this deficiency by relying upon *Keegan*. However, as noted above, there is no teaching in *Keegan* of "the electrical stimulation is adapted to mimic a sequencing of at least two muscle groups proximate to the body segment and is sufficient to achieve visible and forceful contraction of the at least two muscle groups."

Moreover, it is respectfully submitted that the applied combination of *Reiss* and *Cywinski* is nothing more than the result of improperly applied hindsight reconstruction in view of the present specification. As the Supreme Court recently reiterated:

As is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007). Moreover, "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." Id. at 1742.

In this case, even assuming, *arguendo*, that the claimed elements were independently known, there is no support in the references for the applied combination. Rather, the Office Action provides no explanation of the basis of the combination. Certainly, there is no citation to

² As noted above, it is respectfully submitted that the applied references do not teach all of the features of independent Claims 1 and 8.

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anything in the art that would provide the requisite motivation to combine the references. As a

result, it is evident that the outstanding Office Action has engaged in exactly the type of

hindsight reconstruction that the Supreme Court has cautioned against.

Accordingly, as the combination of Reiss and Cywinski is the result of impermissible

hindsight reconstruction and fails to disclose or suggest the features of independent Claim 39,

from which Claims 43 and 44 depend, it is respectfully submitted that the outstanding Office

Action has failed to provide a prima facie case of obviousness. It is therefore respectfully

requested that this rejection be withdrawn.

V. CONCLUSION

Consequently, in view of the foregoing discussion, it is respectfully submitted that this

application is in condition for allowance. An early and favorable action is therefore respectfully

requested.

Respectfully submitted,

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MCG/KPB/rc

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